



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,724	03/15/2004	Hansjorg Ander	3868-0156P	2073
2292 7590 04/15/2010 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER DESAL, ANISH P				
ART UNIT 1787		PAPER NUMBER		
NOTIFICATION DATE 04/15/2010		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/799,724

Applicant(s)

ANDER ET AL.

Examiner

ANISH DESAI

Art Unit

1787

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21, 22, 24, 26, 27, 29 and 36-45 is/are pending in the application.
- 4a) Of the above claim(s) 36 and 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21, 22, 24, 26, 27, 29 and 38-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed on 02/24/10 after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/24/10 has been entered.
2. Applicant's amendment to claim 42 overcomes 112-first paragraph rejection as set forth on page 3, section 6 of 09/24/09 Office Action (OA).
3. Applicant's amendment to claims 42-43 overcomes 112-second paragraph rejection as set forth on page 3, section 8 of 09/24/09 OA.
4. In view of applicant's amendment to claim 1 by deleting "di, tri and higher (meth)acrylates", 103(a) rejections based on Wambeke et al. (US 5,741,014) in view of Bonk et al. (US 4,731,273) are withdrawn because neither Wambeke nor Bonk disclose "wherein said material is produced by polymerization of a polymerizable mass consisting of at least one compound selected from the group consisting of aromatic (meth)acrylate...and at least acrylic acid and/or methacrylic acid monomers" as claimed.
5. In view of applicant's amendment a new 102/103 rejection based on Komiyama et al. (US 5,118,567) is made.
6. In view of applicant's amendment, new 112-first paragraph rejections are made.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. **Claims 21, 22, 24, 26, 27, 29, and 38-45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.**
8. With respect to claim 21, it is noted that specification (e.g. paragraph 0015, 0022, and 0026 of US PG PUB of this application) provides support to recite that the polymerizable mass consists of "at least one compound selected from the group consisting of aromatic (meth)acrylate, alicyclic (meth) acrylates, polycyclic (meth)acrylates, heterocyclic (meth)acrylates, epoxide acrylates, epoxides" in combination with acrylic acid and/or methacrylic acid. However, specification fails to provide support for "vinyl ethers, vinyl esters, and styrene" in combination with acrylic acid and/or methacrylic acid as claimed.
9. Additionally, with respect to claim 21 recitation "a radiation sensitive initiator in an amount ranging from 0.0 to 5 wt%", specification fails to provide support for "0.0 wt%" of

radiation sensitive initiator. While applicant's response (see page 11) points to paragraphs 0019 and 0020 for support, the Examiner submits that said paragraphs does not provide support to recite amount of radiation sensitive initiator in the range of "0.0 wt% to 5 wt%" as claimed. Specification as originally filed provides support only to recite amount of photoinitiator in the range of from 0.5 to 5% (see 0018 in PGPub).

10. Further, with respect to claim 21 recitation "an inorganic filler in an amount ranging from 0.0 to 10% wt of the polymerizable mass", "a flame-proofing agent in an amount ranging from 0.0 to 5% wt. of the polymerizable mass", and "a colorant in an amount ranging from 0.0 to 2% wt. of the polymerizable mass", the specification as originally filled fails to provide support to recite the amount of the aforementioned ingredients in the range as claimed. While applicant points to paragraph 0019 and 0020 for support, the Examiner submits that while paragraph 0019 states that the additives such as resins, fillers, flame-proofing agents, colorants etc. are **optional** (interpreted as 0%-wt), this does not provide a support to create a range of e.g. 0.0 to 10% for inorganic filler, 0.0 to 5% for flame-proofing agent, and 0.0 to 2% for colorant. For example, 0020 states amount of fillers to be 0.1 to 10% and 0019 states that the filler can be optional, however this can not be interpreted that applicant has support to create a new range of , 0.0% to 10%, because between 0.0% and 0.1%, there are values such as 0.01, 0.02, 0.03 etc. for which there is no support.

11. Additionally, with respect to the amount of flame-proofing agent (i.e. 0.0 to 5% wt), there is no support to recite upper end point of 5% wt as claimed.

Art Unit: 1794

12. Regarding claim 43, recitation of "hollow bodies", there is no support in the specification to broadly recite "hollow bodies". While there is a support to recite "**adhesive hollow bodies**" (see 0011 of Pg Pub), there is no support to broadly recite "hollow bodies".

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. **Claims 21, 26, 38, 42, and 43 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Komiya et al. (US 5,118,567).**

14. With respect to claim 21, since the weight% of inorganic filler, flame-proofing agent, and colorant includes zero, these components are interpreted as optional.

Art Unit: 1794

15. Regarding claim 21, Komiyama teaches a PSA tape (column 1 lines 5-10). Further, as to claim limitation of "...which has a three-dimensional structure and a defined cross-sectional contour, wherein said material is present in a form of strings, strands or strips, wherein said strings, strands or strips have a round, semicircular, oval, elliptical, triangular...and a surface that is bent, curved or provided with edges corresponding to said cross-sectional contour", the Examiner submits following:

16. As shown in Figure 1, the PSA layer 3 of Komiyama has length and height. Additionally, while Figure 1 of Komiyama does not disclose width of said PSA layer, the width is inherent to the PSA tape (including PSA layer). As such, the PSA of Komiyama inherently has 3D structure. Further, the PSA tape of Komiyama is interpreted to read on the "wherein said material is present in a form of strips" as claimed.

17. As to the claim limitation of a defined cross-sectional contour and specific shape of the cross-sectional contour (i.e. round, semicircular, oval, elliptical, triangular, quadrangular, V-shaped, polygonal or irregular cross-sectional contour), given that the PSA of Komiyama has length, width, and height (e.g. like a slab), if one were to take a cross-section and examine cross-sectional contour, it would inherently meet "polygonal, quadrangular [i.e. rectangular] and irregular" cross-sectional limitation in claim 21. Further, as to claim limitation of surface that is bent or provided with edge corresponding to said cross-sectional contour", it is submitted that the aforementioned cross-sectional contour of Komiyama's product would intrinsically have a surface that is

bent (in the case of rectangular (quadrangular) cross-sectional contour) or provided with edges corresponding to said cross-sectional contour.

18. Additionally, as to the claim limitation of wherein the strips have a round, semicircular, oval, elliptical, and V-shaped cross-sectional contour and a surface that is curved, it is submitted that Change in shape is not patently distinct over the prior art absent persuasive evidence that the particular configuration of the claimed invention is significant (see MPEP 2144.04 (IV)(A)).

19. With respect to claim 21 limitation "wherein said material is produced by polymerization of a polymerizable mass consisting of at least one compound selected from the group consisting of...and at least one other compound selected from the group consisting of acrylic acid and/or methacrylic acid monomers", said limitation is a product by process limitation. The product by process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. "Even though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

Art Unit: 1794

20. Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir.1983).

21. In the presently claimed invention, applicant polymerizes a polymerizable mass which contains "at least one compound selected from the group consisting of...and at least one other compound selected from the group consisting of acrylic acid and/or methacrylic acid monomers and a radiation sensitive initiator in an amount ranging from 0.0 to 5% wt".

22. It is noted that at column 7 lines 35-40, Komiyama teaches curing (polymerization) of adhesive composition (polymerizable mass). Further, the polymerizable mass of Komiyama includes a methacrylate polymer, an epoxy resin, a photopolymerizable low molecular weight compound, a heat activable potential curing agent for the epoxy resin and a photopolymerization initiator for the photopolymerizable low molecular weight compound. At column 3 lines 31-39, Komiyama discloses that the (meth)acrylate polymer can be a copolymer of at least one (meth)acrylate and at least one comonomer such as acrylic acid. Further, as (meth)acrylate, at column 3 lines 25-26 Komiyama discloses glycidyl acrylates and methacrylates (equated to read on applicant's at least one compound selected from the group consisting of aromatic

Art Unit: 1794

methacrylate, heterocyclic methacrylate, epoxide acrylates and epoxides). Further, at column 4 lines 55-68 and at column 4 lines 30-35, Komiyama discloses epoxides (as epoxy resin) and epoxy acrylate (as low molecular weight compound) respectively. Additionally, at column 4 lines 49-53, Komiyama discloses heat activable potential curing agents such as onium salts (equated to read on applicant's radiation sensitive initiator) and at column 5 lines 4-5 Komiyama discloses photopolymerization initiator (equated to read on applicant's radiation sensitive initiator). As such, the polymerizable mass of Komiyama meets claim limitation of "polymerizable mass consisting of at least one compound selected from the group consisting of aromatic (meth)acrylates, heterocyclic (meth)acrylates, epoxide acrylates, epoxides, and at least one other compound selected from the group consisting of acrylic acid and/or methacrylic acid, a radiation sensitive initiator" as claimed.

23. Further, as to the weight% of the radiation sensitive initiator as claimed, Komiyama discloses heat activable potential curing agent such as onium salt (radiation sensitive initiator A) in the amount of 0.1 to 50 parts by weight per 100 parts by weight of the epoxy resin (column 4 lines 45-57), and another radiation sensitive initiator (radiation sensitive initiator B) in the amount of 0.1 to 10 parts by weight per 100 parts by weight of the photopolymerizable low molecular weight compound (e.g. epoxy acrylate) (see column 4 lines 30-35 and column 5 lines 10-15).

24. Based on above and the fact that the polymerizable mass of Komiyama (based on 100 parts by weight of methacrylate) includes 100 parts methacrylate (e.g. glycidyl methacrylate) (see column 4 lines 20-21), 2,000 parts of epoxy resin (see column 4 line

Art Unit: 1794

19), and 1,000 parts of epoxy acrylate (see column 4 lines 38-40). Further, the amount of radiation sensitive initiator A is 2 parts (calculated for 2,000 parts epoxy resin as $(0.1 \text{ parts of radiation sensitive initiator A} / 100 \text{ parts of epoxy}) * 2,000 \text{ parts epoxy} = 2 \text{ parts}$) and the amount of initiator B is 1 parts (calculated for 1,000 parts epoxy acrylate as $(0.1 \text{ parts of radiation sensitive initiator B} / 100 \text{ parts of epoxy acrylate}) * 1,000 \text{ parts of epoxy acrylate} = 1 \text{ parts}$). As such based on the polymerizable mixture containing 100 parts methacrylate, 2,000 parts epoxy resin, and 1,000 parts of epoxy acrylate, the total weight% of radiation sensitive initiation A and B is 0.097% (calculated as $(2 \text{ parts of A} + 1 \text{ parts of B}) / (100 + 2,000 + 1,000) = 0.00097$ or 0.097% wt). Thus, the weight% of radiation sensitive initiator of Komiyama is within the range of 0.0 to 5% wt of the polymerizable mass as claimed.

25. Based on the above, there appears to be no difference in structure of material produced by polymerization of a polymerizable mass as claimed in the present invention and the material (PSA) of Komiyama.

26. As to claim 26, the disclosure of Komiyama at column 3 lines 60-62 relating to bisphenol A meets claim requirement of "wherein the epoxide is based on bisphenol A".

27. As to claim 38, the PSA of Komiyama as shown in Figure 1 is present as continuous material.

Art Unit: 1794

28. With respect to claims 42 and 43, it is submitted that these claims are directed to product by process limitation. Product by process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. "Even though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. As set forth with respect to claim 1 above, the end product of Komiya is same as that of claimed by applicant (i.e. Komiya's PSA has polygonal, quadrangular [i.e. rectangular] and irregular cross-sectional contour and a surface that is bent or provided with edge corresponding to said cross-sectional contour).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

29. **Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Komiyama et al. (US 5,118,567) as applied to claim 21 above, and further in view of Spada et al. (US 6,293,037B1).**

30. Komiyama is silent as to teaching claim 22.

31. However, Spada disclose a PSA that contains isobornyl acrylate and alkyl acrylate (abstract). At column 3 lines 15-25, Spada discloses that isobornyl acrylate is a high boiling, low odor, low toxicity, ethylenically unsaturated monomer that has profound effect on the adhesive and rheologic properties of the resulting PSA.

32. As such, it would have been obvious to select isobornyl acrylate in formation of the PSA given that isobornyl acrylate has low toxicity and it can be used to provide desired rheological characteristics to PSA.

33. **Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Komiyama et al. (US 5,118,567) as applied to claim 21 above, and further in view of Bemmels et al. (US 3,617,362).**

34. Komiyama is silent as to teaching claim 24.

35. However, Bemmels discloses a self-crosslinking acrylate PSA (abstract). The PSA of Bemmels includes a cohesion inducing monomer such as vinyl acetate (column 1 lines 55-60).

Art Unit: 1794

36. As such, it would have been obvious to use vinyl acetate in the acrylic based PSA so as to provide suitable cohesiveness to the resulting adhesive.

37. **Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Komiyama et al. (US 5,118,567) as applied to claim 21 above, and further in view of Melby (US 4,388,448).**

38. Komiyama is silent as to claim 27.

39. However, Melby discloses a homopolymers of glycidyl methacrylate (GMA) (see abstract). At column 2 lines 50-56, Melby discloses that "However, for uses such as adhesives or finishes, the polymer must contain chemically functional groups which can participate in crosslinking reactions either by thermosetting or air-curing..."

40. Thus, it would have been obvious to select the GMA (homopolymer of GMA) as presently claimed as taught by Melby, given that said GMA provides chemical modification so as to provide water dispersibility and improved adhesion (see column 2 lines 50-56 of Melby).

Art Unit: 1794

41. **Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Komiyama et al. (US 5,118,567) as applied to claim 21 above, and further in view of Lautenschlaeger et al. (US 4,814,215).**

42. Komiyama is silent as to teaching claim 29.

43. However, Lautenschlaeger discloses an adhesive composition, process and product. Moreover, Lautenschlaeger discloses that photo-initiators are used to increase the rate of cure in the case of cure by UV radiation (column 11, lines 42-43). Further, Lautenschlaeger discloses typical examples of photoinitiators such as Irgacure 184 (1-hydroxy-cyclohexyl-phenyl-ketone) (column 11, lines 47-48).

44. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a suitable photoinitiator from Lautenschlaeger in Komiyama, because selecting a known compound to meet known requirements involves routine skill in the art.

45. **Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Komiyama et al. (US 5,118,567) as applied to claim 21 above, and further in view of Woods (US 4,414,275).**

46. Komiyama is silent as to teaching wherein the material is present as rolled material.

47. However, Woods discloses a PSA tape (abstract) and at column 7 lines 25-27, Woods discloses of providing the tape in a **rolled form** for packaging purpose. As such,

it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the material in a rolled form so as to easily package the material and ship it. Further, it is well known that the adhesive tapes are commonly provided in a rolled form so that they can be easily stored and shipped.

48. Claims 39 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komiya et al. (US 5,118,567) as applied to claim 21 above, and further in view of Czepele et al. (US 4,277,532).

49. Komiya is silent as to teaching the thickness of the sealing material as claimed.

50. However, Czepele discloses thermally-expandable sealants for joints, cavities or holes (abstract). Further at column 4 lines 10-15, Czepele discloses a sheet-like joint sealant having a thickness of 1.9 mm, which meets applicant's claimed thickness of 0.5 to 10 mm (claim 39) and 0.5 to 50 mm (claim 41).

51. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the PSA sealing material having the thickness as taught by Czepele, motivated by the desire to produce a PSA sealing material having a suitable thickness. Alternatively, absence any criticality associated with the thickness of the sealing material, selection of a suitable thickness of the sealing material including that of presently claimed would have been obvious, motivated by the

Art Unit: 1794

desire to provide sealing material with suitable thickness so that it can be easily handled.

52. Alternatively, absence any evidence of criticality associated with the thickness of the strings, strands, or strips, selection of a suitable thickness including that of the present claimed would have been obvious depending on the intended use of the PSA material or a sealing material.

53. **Claims 40, 44, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komiyama et al. (US 5,118,567) alone.**

54. With respect to claim 40, it is noted that Komiyama discloses general conditions of claim except for the dimensions of the material as claimed in claim 40. Specifically Komiyama as applied to claim 21 discloses presently claimed PSA material having a 3D structure and a defined cross-sectional contour (e.g. quadrangular) and has a surface that is bent or provided with edges corresponding to said cross-sectional contour. Additionally, the composition of Komiyama PSA is same as that of disclosed by applicant's invention. Therefore, selecting a proper ratio of width to height as claimed would have been obvious, motivated by the desire to suitably form material that can be used for desired intended use. Alternatively, it is submitted that Change in size is not patently distinct over the prior art absent persuasive evidence that the particular configuration of the claimed invention is significant (see MPEP 2144.04 (IV)(A)).

55. With respect to claims 44-45, it is submitted that in absence of any criticality associated with the viscosity values, one would have reasonably selected viscosity of

Art Unit: 1794

the polymerizable mass including that of presently claimed, in order to properly process the polymerizable mass to produce a sealing material with a desired shape.

Specifically, it is noted that if one of ordinary skill in the art selects the polymerizable mass with viscosity that is too low or too high, then it will be difficult to process the polymerizable mass into a suitable shape. For example, if a viscosity is too high, it will be difficult to fill the tubular bodies with the polymerizable mass or to coat the polymerizable mass onto a support. This will also impact the shape of the end product. Thus, it would have been obvious to select the polymerizable mass with desired viscosity including that of presently claimed, motivated by the desire to produce a sealing material with a desired shape.

Response to Arguments

56. Applicant's arguments filed on 02/24/10 have been fully considered but they are not persuasive.

57. On page 13 of the amendment, applicant argues that "The references of Czepel et al. Woods, Stanek, Flint, Komiyama and Lautenschlager were merely cited for teaching additional features recited in the dependent claims. However, as these

Art Unit: 1794

references neither disclose the specific composition of the presently claimed pressure sensitive adhesive, nor the formation of the....”

58. This is not found persuasive, because as set forth in the present OA, Komiyama anticipates applicant's PSA composition including the 3D structure and defined cross-sectional contour. As per prior arts of Czepel, Woods, and Lautenschlager, the Examiner submits that while said prior art references do not disclose all the features of the present claimed invention, said references are used as teaching reference, and therefore, it is not necessary for these secondary references to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather these references teach a certain concept, namely Czepel discloses claims 39 and 41, Woods discloses claim 38, and Lautenschlager discloses claim 29 and in combination with the primary reference, discloses the presently claimed invention.

Conclusion

59. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANISH DESAI whose telephone number is (571)272-6467. The examiner can normally be reached on Monday-Friday, 9:00AM-5:30PM.

Art Unit: 1794

60. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

61. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. D./

Examiner, Art Unit 1787

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1787